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08/945667

APPLICATION NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO.
08/945667	01/28/99	HORROBIN	20000770942

023370
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HM22/0420

EXAMINER

HIGEL, F

ART UNIT

PAPER NUMBER

1626

19

DATE MAILED: 04/20/01

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

OFFICE ACTION SUMMARY

- ☒ Responsive to communication(s) filed on April 2, 2001
- ☐ This action is FINAL.

- ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire THREE month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

- ☒ Claim(s) 27, 29, 30, 36 to 38 AND 56 to 95 is/are pending in the application.
- Of the above, claim(s) 57 to 92 is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 27, 29, 30, 36 to 38, 44, AND 53 to 95 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
- ☐ received.
- ☐ received in Application No. (Series Code/Serial Number) _____
- ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

- ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- ☐ Notice of Reference Cited, PTO-892
- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☐ Interview Summary, PTO-413
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Notice of Informal Patent Application, PTO-152

SEE OFFICE ACTION IN THE FOLLOWING PAGES--

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The request filed on April 2, 2001 for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application No. 08/945,667 is acceptable and a CPA has been established. An action on the CPA follows.

Claims 57 to 92 stand withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 9.

Claim 30 is rejected under 35 USC 112, second paragraph, for failing to properly define the invention. The expressions "compound which comprises" and "other difunctional acid linking moiety" renders the claim indefinite by placing no definite limits or boundaries on the claims. The uses of "comprises" is not permitted in the claiming of compounds.

Claims 27, 29, 30, 36 to 38, 56, and 93 to 95 are rejected under 35 U.S.C. 103(a) as being unpatentable over European Patent No. 0,161,114, of record.

The reference discloses compounds which are homologs, isomers or close structural analogs of the claimed compound as please note for example, Example 1, page 4, Figures 1 to 6 and Table 5 of the reference. The claimed compounds are so clearly related structurally to the claimed compounds as to be structurally obvious there from in the absence of any unobvious or unexpected properties, especially since one of ordinary skill in the art would expect that compounds so closely related would have the same or essentially the same properties and would be led to make all such compounds closely related structurally with the expectation that such compounds would have the same or essentially the same properties. ^{No}~~is~~ showing of any

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unobvious or unexpected properties has as of yet been forthcoming. For a reference to be a good reference is that it disclose structurally similar compounds and have a ^{viable} ~~reasonable~~ utility thus utility does not have to be the same as that possessed by the claimed compounds. Applicants must show an unexpected or unobvious difference in a ^{property} ~~properties~~ not a different property.

No claim is allowed.

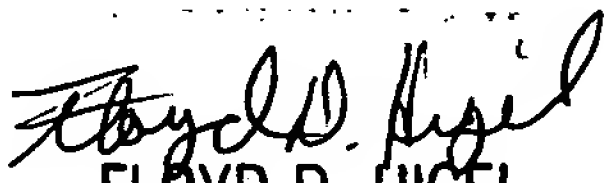
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Floyd D. Higel whose telephone number is (703) -308-4530. The examiner can normally be reached on Tuesday through Friday from 8:00 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph McKane, can be reached on (703) -308-4537. The fax phone number for the organization where this application or proceeding is assigned is (703) -308-7921.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) -308-1235.

Higel/LR

April 19, 2001


FLOYD D. HIGEL
PATENT PRIMARY EXAMINER
ART UNIT ~~123~~ 1626
